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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Travis J. Parry

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EXAMINER

LANIER, BENJAMIN E

ART UNIT

PAPER NUMBER

2432

NOTIFICATION DATE

DELIVERY MODE

09/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/829,644	Applicant(s) PARRY ET AL.	
	Examiner BENJAMIN E. LANIER	Art Unit 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34,37,38,41-51 and 54-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34,37,38,41-44 and 60 is/are allowed.
- 6) ☒ Claim(s) 1-11,13-25,27,28,30-33,45-51,54,55,58,59 and 61 is/are rejected.
- 7) ☒ Claim(s) 12,26,29,56,57 and 62 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 16 August 2010 amends claim 34. Claims 39 and 40 have been cancelled. Claims 61 and 62 have been added. Applicant's amendment has been fully considered and entered.

Response to Arguments

2. Applicant argues, "A complete reading Asakura correctly reveals that the 'user ID code' discussed by Asakura is in fact an identification of the supplier of the cartridge (the agency or service center which installed the original cartridge in the printer), NOT authorized users of the cartridge." This argument is not persuasive because Applicant has failed to provide evidence that the *user ID* of Asakura is associated to anyone but an actual user.

3. Applicant argues, "Nowhere does enter disclose anything about the 'user ID code' including individuals." In response, user ID is a term of art known to relate specifically to individuals.

4. Applicant argues, "Asakura fails to disclose coupling authorization data includes coupling an optically readable code for providing the authorization data to the consumable resource." This argument is not persuasive because Asakura discloses a printing system wherein consumable cartridges include user id information and a count value that are read from the cartridge by the printer to control access to the cartridge (Col. 3, line 22 - Col. 4, line 7, 30-50). Applicant has failed to specify how Asakura is believed to be deficient.

5. Applicant argues, "the system of Hanaoka does not determine whether a person is authorized to use the ink in the cartridge of Hanaoka based upon what the person enters as his or

Art Unit: 2432

her permit ID." This argument is not persuasive because authenticating a user for use of the printer rental system authenticates the user for use of the ink.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

7. Applicant's arguments with respect to claims 34, 37-44 and 60 have been fully considered and are persuasive. The rejections of claims 34, 37-44, and 60 have been withdrawn.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 46-51 are rejected under 35 U.S.C. 102(a) and/or 102(e) as being anticipated by Asakura, U.S. Patent No. 6,711,362. Referring to claims 46-48, 50, 51, Asakura discloses a printing system wherein consumable cartridges include user id information and a count value that are read from the cartridge by the printer to control access to the cartridge (Col. 3, line 22 - Col. 4, line 7, 30-50), which meets the limitation coupling authorization data identifying authorized users of the resource to the resource, coupling the resource to the image-forming device, sensing the authorization data, and limiting use of the resource by the device based upon

Art Unit: 2432

the sensed authorization data, limiting use of the resource includes preventing any use of the resource by an individual not included in the authorization data, coupling authorization data to the resource includes recording authorization data upon a memory coupled to the consumable resource, coupling authorization data includes coupling an optically readable code for providing the authorization data to the consumable resource.

Referring to claim 49, Asakura discloses that if the user ids do not match a message is displayed to the user (Col. 4, lines 43-47), which meets the limitation of notifying unauthorized individuals that they are not authorized to use the resource.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-11, 13-15, 18-25, 27, 28, 30, 33, 45-51, 54, 55, 59, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanaoka, U.S. Publication No. 2006/0045595, in view of Asakura, U.S. Patent No. 6,711,362. Referring to claims 1, 10, 11, 14, 15, 18-20, 22, 23, 27,

Art Unit: 2432

28, 30, 33, 45-48, 50, 51, 54, 55, 61, Hanaoka discloses printer rental system that includes a printer (Figure 1, 100), which meets the limitation of an image-forming device. The printer utilizes cartridges delivered by the rental service (Figure 1), which meets the limitation of a first consumable resource configured to be consumed by the device in forming a printed image. The printer authenticates use of the cartridge by comparing a manually entered use permit ID ([0080]) with a previously stored use permit ID ([0073]), which meets the limitation of a user interface configured to receive authorization input from a prospective user, the device includes an authorization receiving interface having at least one electronically conductive contact, the user interface is configured to receive authorization input from a prospective user comprising a person, a cartridge containing the consumable resource. The printer authenticates use of the printer by authenticating the user and the cartridge ([0070]), which meets the limitation of a processor in communication with the user interface, wherein the processor is configured to determine if a prospective user is authorized to use the resource based upon the authorization input and interaction with the granting interface, the processor is fixedly coupled to the device/resource, limiting use of the resource by the device based upon the sensed authorization data, limiting use of the resource includes preventing any use of the resource by an individual not included in the authorization data, the processor is configured to determine if the prospective user is authorized to use the resource based upon a comparison of the authorization input and interaction with the granting interface, wherein the prospective user is authorized to use the resource if the authorization input and interaction with the granting interface satisfy a predefined relationship. Hanaoka does not disclose that the cartridge stores authorized user id information. Asakura discloses a printing system wherein consumable cartridges include user id information

Art Unit: 2432

and a count value (Col. 3, line 30 - Col. 4, line 7), which meets the limitation of an authorization granting interface coupled to the resource and configured based upon authorized users of the resource, the authorization granting interface is configured to remain coupled to unused portions of the consumable resource upon withdrawal of the unused portions of the consumable resource from the image forming device, the authorization granting interface includes a digital memory coupled to the cartridge, the authorization granting interface comprises at least electronically conductive contact, a programmable medium coupled to the cartridge and providing the authorization data, the authorization granting interface is configured to grant and deny use of the resource, the authorization granting interface is coupled to the cartridge, coupling authorization data identifying authorized users of the resource to the resource, sensing the authorization data, coupling an optically readable code for providing the authorization data to the consumable resource, the authorization granting interface identifies a person who is authorized to use the resource, coupling authorization data to the resource includes recording the authorization data upon a memory coupled to the consumable resource, the authorization granting interface is configured to grant and deny use of the resource, the processor is configured to prevent the prospective user from using the first consumable resource in the image forming device based on input of a first authorization input and interaction with the granting device by the first prospective user, wherein the processor is configured to allow the prospective user to use a second consumable resource in the image forming device based upon input of the first authorization input and interaction with the granting device by the first prospective user. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the consumable cartridges of Hanaoka to store the user id information along with a count value in

Art Unit: 2432

order to prevent use of pirated cartridges while also preventing unauthorized refilling of genuine cartridges as taught by Asakura (Col. 1, lines 17-33 & Col. 4, lines 15-21).

Referring to claims 2, 13, Hanaoka discloses that the user utilizes a computer containing a display which is capable of displaying notification messages (Figure 1, 10), which meets the limitation of the user interface is configured to indicate to the prospective user whether the prospective user is authorized in response to control signals generated by the processor, the user interface includes a mouse, a keyboard.

Referring to claims 3, 4, Hanaoka discloses that the printer authenticates use of the printer by authenticating the user and the cartridge ([0070]), which meets the limitation of the processor is configured to prevent use of the resource by the prospective user when the prospective user is not authorized and to permit use of the resource when the prospective user is authorized.

Referring to claim 5, Hanaoka discloses that the use permit ID is stored in the printer ([0073]), which meets the limitation of a memory configured to receive and store authorization input.

Referring to claims 6-9, 24, 25, Hanaoka discloses that the cartridge can be an ink or toner cartridge ([0084]), which meets the limitation of the resource includes a printing material configured to be deposited upon a medium, the printing material comprises an ink, the printing material comprises a toner, the resource is contained within a cartridge.

Referring to claim 21, Hanaoka discloses that the use permit ID is received from a server ([0072]), which meets the limitation of the user interface is configured to receive authorization input from a prospective user comprising a device.

Referring to claim 49, Hanaoka discloses that an error message is received when the user is not authenticated ([0073]), which meets the limitation of notifying unauthorized individuals that they are not authorized to use the resource.

13. Claims 16, 17, 31, 32, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanaoka, U.S. Publication No. 2006/0045595, in view of Asakura, U.S. Patent No. 6,711,362, and further in view of Haruna, JP 2003122209. Referring to claims 16, 17, 31, 32, and 58, Hanaoka does not disclose varying levels of access to the resource. Haruna discloses an accounting system for use in the printing environment wherein users prepay for a predetermined amount of resources ([0031] & [0037]), which meets the limitation of the authorization granting interface is configured to grant varying levels of authorization to use of the resource, the processor is configured to allow limited non-zero use of the first consumable resource in the image forming device. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the users in Hanaoka to prepay for printing resources as discussed in Haruna in order to provide users with the ability to pay only for what they need as suggested by Haruna ([0004] & [0062]).

Allowable Subject Matter

14. Claims 34, 37, 38, 41-44, and 60 are allowed.

15. Claims 12, 26, 29, 56, 57, and 62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Art Unit: 2432

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN E. LANIER whose telephone number is (571)272-3805. The examiner can normally be reached on M-Th 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2432

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin E Lanier/
Primary Examiner, Art Unit 2432